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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,172

03/21/2007

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EXAMINER

GHALLI, ISIS A D

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

10/03/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	Application No.	Applicant(s)
	Examiner	Art Unit
	10/584,172	ADACHI ET AL.
	Isis Ghali	1611

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 22 September 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-3,9,13,14,17,18,21 and 23.
- Claim(s) withdrawn from consideration: 4-8,15,16,19,20 and 22.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 09/22/2011
13. ☒ Other: Amendment drawing is entered.

/Isis Ghali/  
Primary Examiner, Art Unit 1611

The drawing and IDS filed 09/22/2011 have been entered.

Claims 1-3, 9, 13, 14, 17-18, 21, 23 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 12/087,055.

Claims 1-3, 9, 13, 14, 17-18, 21, 23 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 7,883,504.

Applicants argue that claims as amended recite that the portion of the support around the opening is depressed toward the absorber compared to the other portion, or wherein the support inclines from the peripheral portion toward the opening with respect to the absorber, and this limitation not recited by US 7,883,504 or copending application 12/087,055.  
covers the structure currently claimed.

In response to this argument, it is argued that the present claims are earlier filed, and they anticipate the copending claims and the issued patent. The present claims as amended are narrower and anticipate the broader issued claims and copending claims because all the limitations of the issued claims and the of the copending claims are recited by the present claims. The present claims considered as species of the claims of the copending application and the claims of the issued patent, and species anticipates the genus.

Claims 1-3, 9, 13, 14, 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Heiber et al. (US 4,917,676), Wakizaka et al. (JP 09-124468), and Konno et al. (US 4,842,577). Claims 17, 18 and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Heiber, Wakizaka and Konno as applied to claims 1-3, 9-14 and 23 above and further in view of Blum et al. (US 7,337,593).

Applicants argue that the cited art does not disclose or suggest that the space 110 in Fig. 11 or the space 120 in Fig. 12 is formed in the patch by providing the structures recited in Claim 1. The rejection set forth in the final Office Action was meant to encompass claims 13 and 14, which recited the elements now present in claim 1. However, the Office Action failed to set forth a specific rationale behind the rejection of claims 13 and 14. This is because cited references fail to disclose or suggest the structures now recited in claim 1.

In response to this argument, it is argued that Heiber teaches two reservoirs 2 and 3 on top of each other, one contains an activating substance and one contains therapeutic agent and separated by non-permeable membrane 10 that may contain a depth slit to weaken the membrane. Membrane 10 is burstable by pressure (col.3, lines 51-53; col.4, lines 41-65; col.5, lines 8-15; figure 3; claims). Once the activating agent brought into contact with the therapeutic agent, the device is activated and drug flow from the reservoir to the skin begins (col.6, lines 10-17). Activating agent can be solvent or solutions to elute the drug (col.7, lines 7-15). The teaching of pressure to burst the membrane will inevitably change the size of the chambers of the reservoirs and inevitably provide portion of the support around the opening is depressed toward the absorber compared to the other portion, or the support inclines from the peripheral portion toward the opening with respect to the absorber. The present claims are directed to product, and all the elements of the product are taught by the prior art in combination and teaches the present invention as a whole. In other words, the claimed depression of the membrane would be expected since Heiber teaches pressure to rupture the membrane and consequently change of the size of the reservoirs. According to MPEP 2112.02, products of substantial identical structure cannot have mutually exclusive properties. Therefore, if the prior art teaches an substantially identical structure, the function claimed by applicant is necessarily present as In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).